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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,652	09/19/2003	Terrance Chen	9450	6546
21905	7590	10/27/2005	EXAMINER	
CONNORS ASSOCIATES 1600 DOVE ST SUITE 220 NEWPORT BEACH, CA 92660			BOTTORFF, CHRISTOPHER	
			ART UNIT	PAPER NUMBER
			3618	

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,652

Applicant(s)

CHEN, TERRANCE

Examiner

Christopher Bottorff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 1-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 58-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/18/03
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election of the method of invention II and the species of Figures 1-1B in the reply filed on October 14, 2005 is acknowledged. Because applicant did not distinctly and specifically point out errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 58-62 are directed to the elected invention and species.

Claims 1-57 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on December 18, 2003 was considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 58-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 58 recites the limitation "the tubular member" in line 10. There is insufficient antecedent basis for this limitation in the claim. For the purposes of examination, the passageway of the tail pipe is interpreted as being the tubular member.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 58-60 and 62 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee US 6,719,085.

Lee discloses a method of decorating a tail pipe 20 of an automotive exhaust system comprising connecting to the tail pipe 20 an ornamental element 18 at or near an exposed, open end of the tail pipe 20. See Figure 1 and column 2, lines 10-11 and 16-17.

The ornamental element 18 includes a propeller, which is a symbol of power and motive force, and the ornamental element 18 is in the shape of the propeller. See Figure 1. The ornamental element 18 is positioned so that an observer when looking at

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the exposed, open end of the tail pipe 20 would see the propeller. See Figure 1. The ornamental element 18 is sized to provide sufficient space to allow exhaust gas to flow through a tubular passageway of the tail pipe 20, past the ornamental element 18, and exit the exposed, open end of the tail pipe 20. See column 1, lines 47-49. The ornamental element 18 is essentially a solid structure that prevents exhaust gas from flowing through the ornamental element 18, and the ornamental element 18 occupies no more than 90 percent of a maximum total area of the exposed, open end of the tail pipe 20. See Figure 1.

In addition, Lee discloses that the propeller of the conventional ornament assembly, in which the propeller is located inside the tail pipe, is not movable. See column 1, lines 21-23. Thus Lee discloses that the claimed method may utilize a stationary ornamental element, as defined in claim 59.

Claims 58, 59, 61, and 62 are rejected under 35 U.S.C. 102(b) as being anticipated by Hummel et al. US 4,696,368.

Hummel et al disclose a method of decorating a tail pipe of an automotive exhaust system comprising connecting to the tail pipe 15 an ornamental element 66 at or near an exposed, open end of the tail pipe 15. See Figures 1-3 and column 2, lines 24-28.

The ornamental element includes a grating 66, which is a symbol of the vehicle's isolation from external threats, and the ornamental element is in the shape of the grating

66. See Figure 3. The ornamental element 66 is positioned so that an observer when looking at the exposed, open end of the tail pipe 15 would see the grating 66. See Figure 1. The ornamental element 66 is sized to provide sufficient space to allow exhaust gas to flow through a tubular passageway of the tail pipe 15, exit the exposed, open end of the tail pipe 15, and pass the ornamental element 66. See Figure 3. The ornamental element 66 is stationary. See Figure 3. The ornamental element 66 is essentially an open structure that allows exhaust gas to flow through the ornamental element 66, and the ornamental element 66 occupies no more than 90 percent of a maximum total area of the exposed, open end of the tail pipe 15. See Figure 3.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Russell, Woods, Jackson, Johnson, Shuen US 6,085,863, Stegall, Horowitz, Liang, Chang, Barnes US D489,664, Macaluso, Barnes US D494,116, Shuen US 6,910,793, and Shuen GB 2 393 481 disclose tail pipe ornaments and methods of decorating a tail pipe.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (571) 272-6692. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Christopher Bottorff".

Christopher Bottorff